

13. (Amended) The method as recited in claim 1 wherein the peptide interacts with endoplasmic reticulum chaperone, the [is a synthetic] peptide selected from the group consisting of TDFTLTI, FTLTISS, FTLKISR, FTLEISR, and LTLKLSR.

REMARKS

This "Remarks" section is divided into the following segments:

- I. Remarks as to the restriction requirement;
- II. Remarks as to the amino acid sequences requirement;
- III. Remarks as to any drawing changes.

I. Remarks as to Restriction Requirement

The December 18, 2001 restriction requirement requires the Applicant to elect a specific method comprising (1) the specific protein such as the ones recited in claims 3 and 9 and (2) the specific peptide such as the ones recited in claims 6 and 12-13.

Species Have Unity

The authority recited for the instant restriction is 35 U.S.C. 121. Applicant respectfully traverses the examiner's restriction request.

While section 121 gives the PTO authority to restrict between claims of an application reciting one or more independent and distinct inventions, it does not provide authority to reject a claim on that basis, with the idea of requiring an applicant to break up the claim and present it as several applications. In Re Weber, 580 F.2d. 455, 458-49. The applicant has a statutory right to claim an invention as he chooses.

Weber held that the PTO cannot require an applicant, under the guise of section 121, to divide up the embodiment of a single Markush claim.

Judge Rich, in the concurring opinion in Weber stated as follows:

"The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim 'embraces' or 'covers' a multiplicity of inventions, in the sense of 'dominating' them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not a sufficient excuse for refusing

to examine a claim on its merits for compliance with 35 U.S.C. §§ 101, 102, 103, and 112. None of those statutory sections, of course, justifies a refusal to examine.”

Aside from the Courts, even the M.P.E.P. (specifically §803.02) advises examiners that they should not refuse to examine a Markush claim that describes what applicants regard as their invention, unless the subject matter in the claim lacks *unity* of invention. In Re Harnish 631 F.2d 716.

Instant Markush claim 9 recites *five* species as Greek fold proteins. Now amended claim 13 recites synthetic peptides which interact with endoplasmic reticulum chaperones. As such, the proteins and peptides have a similar function and structural similarity. This situation is identical to what existed in Harnish, wherein the CCPA found that a *single* structural similarity (a single core structure called a “coumarin group”) sufficiently circumscribed the genus to a single invention.

Applicant merely requests the same deference as was given in Harnish.

Sufficiently Few
Species Recited

Markush claims 9 and 13 contain five proteins and peptides, respectively. A search and examination of all the species at one time will not impose a serious burden on the examiner. 37 C.F.R. 1.146 provides that the examiner may require restriction of the claims to a reasonable number of species before taking any action on the case. The examiner’s authority to invoke an election of species is optional, not mandatory.

In light of the foregoing, Applicant respectfully requests withdrawal of the restriction requirement, and examination of original claim 9 and now amended claim 13.

II. Remarks as to Amino Acid Sequence

The Official Action stated that the application failed to comply with sequence rules 37 C.F.R. 1.821 et seq. Enclosed please find a computer-readable diskette, and hardcopy of the amino acid sequences as found in the application.

Also, please amend the specification and claims of the application, in accordance with said sequence rules, as designated at the beginning of this

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communication.

III. Lack of Drawing Change Requirements

The December 18, 2001 Official Action contained the "Attachment for PTO-948" entitled "Information to Effect Drawing Changes." However, no Notice of Draftperson's Patent Drawing Review was attached to the Official Action. Also, no changes were indicated as needed by the examiner

If the examiner and/or the draftsman requires changes to the drawing, Applicant respectfully requests guidance thereto.


Respectfully submitted,

CHERSKOV & FLAYNIK

By

A handwritten signature in black ink, appearing to read "Michael J. Cherskov", written over a horizontal line.

Michael J. Cherskov
Reg. No. 33,664



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Amended claims-Marked Up Claims Sheet

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In Re: Stevens et al. (09/712,819)
Amended claims–Clean Claims Sheet

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